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09/164,206	09/30/98	DISTER	C 98RE155

EXAMINER	
MILLER, C	
ART UNIT	**PAPER NUMBER**
2857	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/164,206	Dister
Examiner	**Group Art Unit**
Craig Steven Miller	2857

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 11 December 1998.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1-24 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

1. Claims 1-23 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12 lack periods and therefore are not in the required form of a single sentence. Claims 2-11 and 13-22 are rejected to the extent that they inherit the defect of claim 1. For the purpose of interpreting the claims for art rejections, the Examiner has construed claims 1 and 12 with periods at their conclusion.

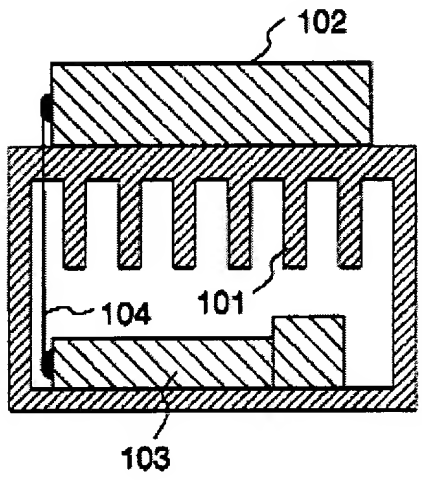
Claim 23 is rejected because it claims a "*container adapted to contain the diagnostic module*". The term "*adapted*" is defined as something having been designed for one use but used for a different purpose. Because applicant has not disclosed the container's original use and because there appears no reason within applicant's specification to perform any such adaptation, it is not clear whether the applicant intended such an adaptation. Should the applicant have intended a container ***for*** containing the diagnostic module, such should be made more clear.

2 The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*
>
> *Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emori *et al.* or Root *et al.*

As to claims 1-6, 9-11, 13-18, 23 and 24, said claims are directed towards a machine with a container mounted outside the machine which receives operation data from the machine with a heat dissipation device between the container and the outside of the machine. Root *et al.* discloses a heat producing device [14], heat dissipating fins [a-d and w-z] and mounting fins [11 and 12]. To the left is an image of figure 1 from Emori *et al.* Item [102] is a high heat generating device, items [103] are electronics which should be heat insulated yet electrically connected to item [102]. Items [101] are heat dissipating fins. Neither Root *et al.* nor Emori *et al.* specify that the heat generation device is a dynamoelectric machine, that the data concerns the operation of such a machine or that the monitoring electronics [102] are within a separate container. It is noted by the Examiner that a dynamoelectric machine generates heat which is known to be harmful to electronics. It also well known that electronics in general and electronics for dynamoelectric machines require heat insulation from high heat generating sources (see Lakin *et al.* column 1 lines 16+). It is well known to monitor machines in general and rotating machines specifically for their operating state (Applicant admits such in the middle of page 2). The Examiner notes that it is well known to make integral that which was separate, In re Larson, 144 USPQ 347 (CCPA 1965), "*Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involves more than mere mechanical skill. In re Murray, 19 CCPA (Patents) 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 CCPA (Patents) 832, 186 F.2d 735, 88 USPQ 367.*" Because it is known to monitor the operation of a rotating machine, because it is known that dynamoelectric machines generate heat which is harmful to electronics, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate



monitoring electronics and the heat insulation for machine state monitoring electronics arrangement of Root *et al.* or Emori *et al.* within a dynamoelectric machine so as to receive the obvious benefits derived therefrom such as more easily performing admittedly known diagnostics to dynamoelectric machines. The Examiner notes that it is well known to make separate that which was integral, Newwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969), "*The mere fact that a given structure is integral does not preclude its consisting of various elements.*" Because it is known to make separate that which is disclosed as integral, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the monitoring electronics within an arrangement suggested by Root *et al.* or Emori *et al.* within a dynamoelectric machine but with the monitoring electronics in a separate container rather than being installed within an integral container with the heat producing device so as to receive the obvious benefits derived therefrom such as increased heat insulation and increased resistance to EMF interference from the dynamoelectric machine. The Examiner notes that because the outer connecting walls of Root *et al.* and Emori *et al.* are of the same material as the fins, they are for all intents and purposes identical to the claimed mounting heat dissipation means.

As to claim 7, said claim is directed towards the use of curved fins. Because curved fins are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such curved fins and because the applicant fails to claim criticality to such a curved fin, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include curved fins within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 8, said claim is directed towards the use of fins of differing widths. Because fins of differing widths are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such different width fins and because the applicant fails to claim criticality to such different width fins, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different width fins

within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 12, said claim is directed towards the use of fins of differing materials. Because fins of differing materials are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such different fin materials and because the applicant fails to claim criticality to such different fin materials, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different fin materials within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 17, said claim is directed towards the use of fins of differing lengths. Because fins of differing lengths are known generally within the art of device cooling, because it is known generally within the cooling art that heat dissipating fins should be sized so as to prevent inadvertent contact with surfaces, because neither Root *et al.* nor Emori *et al.* preclude the use of such different fin lengths, and because the applicant fails to claim criticality to such different fin lengths, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different fin lengths within the devices of either Root *et al.* or Emori *et al.* as modified above so as to avoid inadvertent contact with a curved surface or as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claims 19-22, said claims are directed towards the use of a fin cooling fan. Because fin cooling fan are known generally within the art of device cooling, because it is known generally within the cooling art that heat dissipating fins can be cooled with a fan, because neither Root *et al.* nor Emori *et al.* preclude the use of a cooling fan, and because the applicant fails to claim criticality to such a cooling fan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a fin cooling fan within the devices of either Root *et al.* or Emori *et al.* as modified above so as to provide enhanced device cooling or as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lakin *et al.* discloses the need for heat insulating electronics within dynamoelectric machines.

Gierer *et al.* discloses electric motor with improved airflow.

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Craig Steven Miller whose telephone number is (703) 305-9730. Art Unit facsimile services are now available at (703) 308-7722.

The Examiner can normally be reached on Mondays and Thursdays from 07:00am-5:30pm EDT. Should repeated attempts to reach the Examiner be unsuccessful, the Examiner's Supervisor, Marc Hoff may be reached at (703) 308-1677.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Craig Steven Miller (ss)
09 April 2001

PATRICK ASSOUAD
PRIMARY EXAMINER